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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/853,850

05/10/2001

Andrew J. Vilcauskas JR.

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/853,850	Applicant(s) VILCAUSKAS ET AL.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on March 9, 2006, wherein:

Claims 1-28 are currently pending;

Claims 9, 11-12, 14-15, and 18;

Claims 19-28 are newly added.

Claim Objections

2. Claims 3, 11, and 14 objected to because of the following informalities:

Claim 3 depends on claim 1 which is a system. Claim 3 reads *the method of claim 1*.

Claims 11 depends on claim 9, a system. Claim 11 reads *the method of claim 9*.

Claim 14 depends on claim 12, a system. Claim 14 reads, *the method of claim*

12.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has added the claim language in claims 9, 12, and 15 to contain the language *said cease and desist module capable of attempting to remove said infringing content from said communication medium service having potentially infringing content*. If the attempt is other than posting a message to the offending party, then the Examiner asserts that the applicant has not described the subject matter in the specification in such a way as to enable one skilled in the art to make or use the invention. How does the module attempt to remove infringing content from a communication medium service? Where is a *communication medium service* disclosed? Any claims dependent on claims 9, 12, and 15 are also rejected.

4. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant claims *assembling and issuing legal notices to at least one party responsible*. If the Applicant is claiming that the assembly and issuance is done completely by the module without human intervention, then the Examiner asserts that the applicant has not described the subject matter in the specification in such a way as to enable one skilled in the art to make or use the invention.

5. Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant claims scanning a first service of a communication medium for potentially infringing content and scanning a second service of a communication medium for potentially infringing content using a second service module. Where is this disclosed in the specification?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney (US 6,289,341) (hereinafter referred to as Barney) in view of Thomas (US 6,401,118) (hereinafter referred to as Thomas).

Referring to claim 1:

Barney discloses a system for detecting and preventing infringement of intellectual property over a communication medium, said system comprising:

(a) a database of intellectual property (Figure 1 (140) IP Database);

(b) at least one service module for interfacing with a communication medium (Figure 1 (160, 170, 180));

(c) a data processing system interfacing with at least one service module and database, said data processing system accessing the database to search and retrieve intellectual property over a communication medium and detecting possible infringements of the intellectual property and producing a list of possible infractors (Figure 1 (110)) intelligent agent (col. 3, line 62 thru col. 4, line 31);

(d) an infraction module interfacing with the data processing system for receiving the list of possible infractors from the data processing system and verifying infringements and producing an actual list of infractors (Figure 1 (120) Site Database, (130) Site Examiner, (150) Favorable Comparison Database (col. 1, line 59 thru col. 2, line 16)).

Barney does not disclose a cease and desist module interfacing with the infraction processing system for receiving the list of actual infractors from the infraction module and attempting to stop the infringements.

However, Thomas disclose a cease and desist module interfactable with the infraction processing system for receiving the list of actual infractors from the infraction module and attempting to stop the infringements (col. 11, lines 44-67; Figure 3 (322)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending

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site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 2:

Barney discloses the at least one service module selected from a group of service modules including Internet Relay Chat (IRC), Usenet news group, WWW, Wide area Information Systems (WAIS), Gopher, FTP (col. 2, lines 17-29; Figure 1 (160, 170, 180))

Referring to claim 3:

Barney discloses wherein the service module is a plurality of service modules interfactable with one another (Figure 1).

Referring to claim 4:

Barney discloses the data processing system further comprises at least one module consisting of at least one database interface module (Figure 1 (110)).

Referring to claim 5:

Barney discloses the data processing system (Figure 1 (110)) further comprising at least one infringement identification module (Figure 1 (120) Site Database) interfacing with at least one service module (Figure 1 (160) (170) (180)) and the infraction module for receiving content input from the service module, comparing the content input to intellectual property, and outputting matches between the content input and the intellectual property (Figure 2; col. 4, lines 8-31).

Referring to claim 6:

Barney discloses said content listing further comprising at least one of Usenet traffic listing, FTP content listing, IRC offering listing, and WWW site listing (col. 2, lines 17-29; col. 3, line 63 thru col. 4, line 29; Claims 2, 8 and 14).

Referring to claim 7:

Barney discloses a reporting module interfacing with the infraction module for summarizing infringements identified by the infraction module (Figure 1 (150) Figure 2 (260); col. 1, line 59 thru col. 2, line 4; col. 4, lines 23-31; col. 5, lines 49-56)

Referring to claim 8:

Thomas discloses a reporting module interfacing with the cease and desist module (col. 11, lines 44-67)

Referring to claim 9:

Barney discloses a system for detecting and preventing intellectual property infringement over a communication medium, said system comprising:

(a) at least one service module for scanning communication medium services for potentially infringing content and capable of passing a reference address from a communication medium service having potentially infringing content (Figure 1 (110); col. 1, line 59 thru col. 2, line 29; col. 4, lines 8-29);

(b) an infringement identification module for receiving the reference address and determining whether potentially infringing content is present (Figure 1 (120 and 130), Figure 2; col. 1, line 62 thru col. 4, line 29; col. 4, line 48 thru col. 5, line 56);

(c) an infraction module for receiving the reference address and identifying infringing content (Figure 1 (130) col. 5, lines 1-56).

Barney does not disclose a cease and desist module for receiving the reference address and attempting to remove the infringing content (col. 11, lines 57-67).

However, Thomas discloses a cease and desist module for receiving the reference address and attempting to remove the infringing content.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 10:

Barney discloses a reporting module for reporting attempts by the cease and desist module to remove infringing content (col. 11, lines 44-67).

Referring to claim 11:

Barney discloses a plurality of service module interfacing with one another to provide a communication link to a possible infractor (Figure 1).

Referring to claim 12

Barney discloses a system for detecting and preventing intellectual property infringement over a communication medium, the system comprising:

(a) at least one service module for scanning a communication medium for potentially infringing content and passing a reference address of a potential infringer (Figure 1 (160, 170, 180); col. 3, line 62 thru col. 4, line 31);

(b) an infringement identification module for receiving the reference address of a potential infringer and determining whether infringing content is present and passing a reference address of an infringer (Figure 1 (110) col. 4, lines 8-31).

Barney does not disclose a cease and desist module for receiving the reference address of an infringer and attempting to remove the infringing content.

However, Thomas discloses a cease and desist module for receiving the reference address of an infringer and attempting to remove the infringing content (col. 11, lines 52-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 13:

Thomas discloses a reporting module (col. 2, lines 57-60; col. 4, lines 4-18; col. 16, line 40 thru col. 18, line 30 Output Reports).

Referring to claim 14:

Barney discloses a plurality of services modules interfacing with one another to provide a reference address of a potential infringer (col. 4, lines 8-15).

Referring to claim 15:

Barney discloses a method for detecting and preventing intellectual property infringement over a communication medium, said method comprising the steps of:

(a) scanning a communication medium for potentially infringing content (col. 2, lines 11-16; col. 3, line 62 thru col. 4, line 31);

(b) passing a reference address of a potential infringer to an infringement identification module (col. 4, lines 8-15);

(c) determining whether infringing content is present (col. 4, lines 19-31; Figure 2; col. 5, lines 1-56).

Barney does not disclose passing a reference address of an infringer to a cease and desist module and attempting to remove the infringing content.

However, Thomas discloses passing a reference address of an infringer to a cease and desist module and attempting to remove the infringing content (col. 11, lines 44-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending

site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 16:

Thomas discloses reporting the results of the scanning step, determining step and attempting step to an owner of intellectual property (col. 4, lines 4-16; col. 11, lines 30- 67; col. 16, line 41 thru col. 18, line 30, Figures 6-8).

Referring to claim 17:

Barney discloses passing a reference address between a plurality of scanning modules to enhance the scanning step (Figure 1; col. 3, line 62 thru col. 4, line 30).

Referring to claim 18:

Barney discloses a system for detecting and preventing intellectual property infringement over a communication medium, the system comprising:

means for scanning the communication medium for potentially infringing content (Figures 1 (100) and 2; col. 3, line 62 thru col. 4, line 31);

means for passing a reference address of a potential infringer (Figure 1 (120); col. 4, line 8-16);

means for identifying infringement comprising;

means for receiving said reference address of a potential infringer (col. 4, lines 8-16 (Figure 1 (120);

means for determining whether infringing content is present (Figure 1 (130); col. 4, lines 16-31 and col. 5, lines 1-56); and

means for passing a reference address of an actual infringer (Figure 1 (110) (130); col. 4, lines 20-31; col. 5, lines 19-34).

Barney does not disclose a means for receiving the reference address of an actual infringer and at least attempting to remove the infringing content.

However, Thomas discloses a means for receiving the reference address of an actual infringer and at least attempting to remove the infringing content (col. 11, lines 30-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to Claims 19-23:

Thomas discloses method and system having a cease and desist module for contacting administrators (operators) of accounts on sites of at least one party responsible for piracy to terminate the site or account in question (col. 11, lines 57-67 automatically generates a cease and desist letter to each offending Web site 120 operator);

said cease and desist module for contacting said at least one party responsible for piracy (col. 11, lines 57-67 automatically generates a cease and desist letter);

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said cease and desist module for assembling and issuing legal notices to said at least one party responsible for piracy (col. 11, lines 57-67 In step 322, the client, using the report, may then take legal action against the operators of the offending web sites);

said cease and desist module for sending a control message containing commands to delete offending material from a server (col. 11, lines 57-67).

Referring to Claims 24-26:

Thomas discloses a system, comprising:

a first service module for interfacing with a first service of a communication medium (col. 6, lines 48-62 monitoring system 100 includes an intellectual property infringement server, "back end" (search engine));

a second service module for interfacing with a second service of the communication medium (col. 6, lines 4-9 and 32-36; col. 4, line 27 thru col. 7, line 35, FTP site 114; col. 12, lines 1-18);

said first service module for reviewing content of the first service for links to a possible infractor (col. 6, line 48 thru col. 7, line 35);

said first service module for providing a communication link to said second service module for follow-up processing (col. 6, line 27 thru col. 7, line 35).

Referring to Claim 27-28:

Barney discloses a method and system, comprising:

scanning a first service of a communication medium for potentially infringing content (col. 1, line 59 thru col. 2, lines 29, col. 4, lines 8-29);

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scanning a second service of a communication medium for potentially infringing content using a second service module (col. 1, line 59 thru col. 2, line 29, col. 4, lines 8-29;

reviewing content for possible infractor (col. 1, line 59 thru col. 2, line 29).

Barney does not explicitly disclose transmitting a communication link for follow-up processing.

However, Thomas discloses transmitting a communication link for follow-up processing col. 6, line 27 thru col. 7, line 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the infringement identification method and system of Barney the contact links disclosed in Thomas so that once a first preliminary set of locations of addresses on the Internet are identified as probable infringers, the probable URL's can be visited and the content downloaded and processed.

Response to Arguments

6. Applicant's arguments filed March 9, 2006 have been fully considered but they are not persuasive.

The Examiner withdraws the rejection under 35 USC Section 101.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the secondary reference, Thomas (col. 10, line 66 thru col. 11, line 12, col. 11, line 56-67 and col. 6, lines 29-62).

The Examiner makes note that applicant has chosen not to present arguments specific to each pending claim.

As for applicant's arguments as to claims 3, 11, 14, and 17, the arguments are directed to the newly amended claim language. The Examiner addresses these arguments in the discussion of the new grounds of rejection for these limitations.

Conclusion

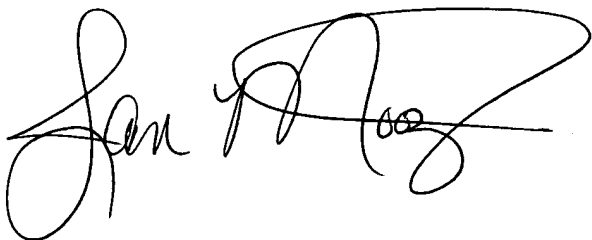
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a large, stylized flourish at the end.

Jan Mooneyham
Patent Examiner
Art Unit 3629